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IN THE

Supreme Court of The United States

October Term, 1944.

No. **486**

THE HOOVER COMPANY,

Petitioner,

vs.

CONWAY P. COE, Commissioner of Patents,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA.**

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vs.

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**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA.**

*To the Hon. The Chief Justice and Associate Justices of
the Supreme Court of the United States:*

Your Petitioner, The Hoover Company, by its undersigned attorneys, respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia to review the judgment of that Court entered in the above cause on July 10, 1944, affirming the dismissal of petitioner's bill of complaint.

A transcript of the record including the proceedings in the said United States Court of Appeals for the District of Columbia is furnished herewith in accordance with Rule 38 in this Court.

Short and Summary Statement of the Matter Involved.

On January 10, 1941, Curtis C. Coons, petitioner's assignor, filed an application for reissue patent in the United States Patent Office of his original patent 2,178,870 which had been granted November 7, 1939, upon an original application filed August 8, 1936. The invention of the application comprises a refrigeration system.

The Examiner in the Patent Office finally rejected Claims 15, 16, 38 and 39 (R. 115), stating that the claims were "rejected as not reading on applicant's disclosure and this rejection is Made Final." Upon appeal the Board of Appeals of the United States Patent Office affirmed the Examiner's decision (R. 131).

Claims 16, 38 and 39, which were finally rejected by the Examiner, originated in the Coons' reissue application. Claim 15 was copied from the patent to Bergholm 2,201,362 (R. 134) for purposes of interference to determine priority of invention.

The Bergholm patent 2,201,362 (R. 134) was filed in the United States Patent Office on November 20, 1937, and issued as a patent on May 21, 1940, being assigned to Servel, Inc., a corporation of Delaware. Bergholm's earliest date in the record is over one year later than petitioner's.

Petitioner filed its complaint (R. 3) in the United States District Court for the District of Columbia under the provisions of Revised Statutes 4915, U. S. C., Title 35, Section 63 (Appendix, p. 3), praying for the relief pro-

vided by Section 4915, R. S. The District Court in a decree (R. 14) dated June 21, 1943, dismissed the complaint, the decision being based upon the merits of petitioner's case. The only question considered by the District Court was the question of whether or not the claims were readable upon the Coons application construction.

Appeal (R. 15) was taken from the decision of the District Court for the District of Columbia to the Court of Appeals for the District of Columbia which, in a decision (R. 140) dated July 10, 1944, affirmed the judgment of the lower Court without touching the merits, the decision being based solely upon the grounds that "the District Court had no jurisdiction over this suit."

Questions Presented.

The decision of the Court of Appeals for the District of Columbia raises three questions of law:

Question 1.

Does Section 4915 R. S. (U. S. C., Title 35, Sec. 63) convey jurisdiction upon the District Court for the District of Columbia of an action begun by bill in equity by an applicant who has been refused a patent by the Board of Appeals where, if the Court holds for the applicant, further prosecution in the Patent Office may take place in "complying with the requirements of law"? (R. S. 4915 at Appendix, p. 3.)

Question 2:

In Section 4915 R. S. (U. S. C., Title 35, Sec. 63), which provides "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference ex-

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aminers, the applicant * * * may have remedy by bill in equity * * *," does the word "or" mean "and," whereby action by both boards must precede applicant's right to the remedy provided?

Question 3.

In an action brought by an applicant for a patent under Section 4915 R. S. (U. S. C., Title 35, Sec. 63) against the Commissioner of Patents as defendant, and following a refusal by the Board of Appeals to grant the patent, is a third party claiming the same invention a necessary party when not involved in interference with the applicant to determine priority of invention but where an interference may be set up by the Patent Office if the Court holds for the applicant?

Reasons Relied Upon for the Allowance of the Writ of Certiorari.

The discretionary power of the Court is invoked upon the following grounds:

- 1. The Questions of Law Presented Depend Upon the Construction of a United States Statute and Are of Great Public Importance.**

The United States Court of Appeals for the District of Columbia in denying the jurisdiction of the District Court has raised several questions of general importance relating to the construction of a Statute of the United States (Revised Statute, Section 4915, as amended by Act of August 5, 1939) (Appendix, page 3). That statute provides for an action by bill in equity whenever a patent is refused by the Board of Appeals of the Patent Office.

The questions potentially affect the right of every applicant for a patent to the relief provided by law from an unjust refusal of a patent in the Patent Office. The facts of the present case are on all fours with the facts mentioned in Footnote (1) of the *Minnesota Mining* case, F. (2d), 62 U. S. P. Q. 119, decided the same day by the same Court and in which the Court said, " * * * It is not clear that the doctrine of *Hoover v. Coe* (No. 8602), decided this day, applies. * * * "

The Rules of Practice in the United States Patent Office are inconsistent with the requirements of the lower Court and make impossible the prerequisites to its jurisdiction which it demands. The statutory duty placed upon the Commissioner of Patents in Section 4904 R. S. also make it impossible for the required prerequisite to be present.

2. The Questions of Law Presented Have Not Been But Should Be Decided by this Court.

The questions of law presented have not been considered by this Court for the decision of the Court of Appeals for the District of Columbia represents a departure from established practice as set forth by that Court in *Pittman v. Coe* (68 F. (2d) 412, 19 U. S. P. Q. 307). For the first time an applicant for a patent is denied the relief provided by Section 4915, R. S., because of what the Patent Office may subsequently do should the applicant prove himself entitled to a favorable decision. The decision is inconsistent with this Court's views as expressed in *Gandy v. Marble* (122 U. S. 432). The decision is in direct conflict with the same Court's decision upon the question of jurisdiction in *Thorne, Neale & Co. v. Coe* (143 F. (2d) 155, 62 U. S. P. Q. 22), decided after the present case was argued and 28 days prior to decision in this case.

As the Commissioner of Patents has his official residence in the District of Columbia, and as today all suits of an *ex parte* nature in which he is named as the sole party defendant are necessarily brought in the District of Columbia, it is entirely unlikely that these questions will be raised in cases arising in other jurisdictions (*Butterworth v. Hill*, 114 U. S. 128). However, under a discarded practice in which in such cases the Commissioner of Patents accepted service in jurisdictions other than the District of Columbia the Circuit Court of Appeals for the Second Circuit in *Gold v. Newton* (254 F. 824) followed a contrary practice, the question of jurisdiction being in issue.

The law of this case has been cited as controlling by the Court of Appeals for the District of Columbia in later decided cases, (*The Colgate-Palmolive-Peet Co. v. Coc*, 125 App. D. C.; 62 U. S. P. Q. 121, *Line Material Co. v. Coc*, 125 App. D. C.; 62 U. S. P. Q. 120).

3. The Court of Appeals Has Not Given Proper Effect to Applicable Decisions of this Court.

The Court below denied that 4915 R. S. (Appendix, p. 3) was a proper method "of reviewing an administrative ruling in a case where plaintiff's right to a patent cannot be determined" (R. 142).

This Court in *Steinmetz v. Allen*, 192 U. S. 543, held that the requirement of "division" made by the Examiner without action upon all the merits of Steinmetz's case was "final and appealable."

This Court in *Frash v. Moore*, 211 U. S. 1, recognized the right of an applicant to bring a bill in equity under Section 4915 R. S. where the refusal of the patent was based upon a requirement for division, with which the applicant refused to comply.

4. The Judgment and Opinion of the Court of Appeals May Seriously Hinder and Confuse the Future Administration of the Law by the Patent Office, Particularly With Respect to Revised Statute 4904.

This reason is believed alone to be adequate to support the granting of the petition (*Federal Trade Com. v. Amer. Tobacco*, 274 U. S. 543, 47 S. Ct. 663).

Section 4904, Revised Statutes, as amended by Act of August 5, 1939 (Appendix, p. 2), provides that the Commissioner of Patents shall direct the setting up of an interference "to determine the question of priority of invention whenever an application is made for a patent which, in the opinion of the Commissioner would interfere with any pending application, or with an unexpired patent." The setting up of the interference is, as noted, made dependent upon the "opinion of the Commissioner" and is not mandatory.

In conformance with Section 4904 (Appendix, p. 2), Revised Statutes, Rule 94 (Appendix, p. 6) of the Patent Office provides for interferences when the claims which recite the common invention "are allowable in the application of each party," or when a patent and an application are involved when the claims "are allowable in all the applications involved."

The decision of the Court of Appeals requires, in order for an applicant for a patent to be entitled to the relief provided by Revised Statutes, Section 4915 (Appendix, p. 3), that the Commissioner set up an interference even though he is of the opinion that the claimed subject matter is not allowable in all the applications.

If the Commissioner is not to deprive applicants for patents of their rights as provided by Revised Statutes, Section 4915, then he must, under the decision of the Court below, set up interferences when in his opinion none prop-

erly should be contested. The function is administrative and properly lies entirely within the Commissioner's discretion.

WHEREFORE your Petitioner respectfully prays that a Writ of Certiorari be issued out of and under the seal of this Court directed to the United States Court of Appeals for the District of Columbia, commanding the said Court to certify and send to this Court on a day designated a full and complete transcript of the record and all proceedings in the Court of Appeals had in this cause, to the end that this case may be reviewed and determined by this court; that the judgment of the said Court of Appeals be reversed; and that said Petitioner be granted such other and further relief as may be deemed proper.

THE HOOVER COMPANY,

Petitioner.

By RICHARD R. FITZSIMMONS,

WILLIAM D. SELLERS,

Attorneys for Petitioner.

WILLIAM S. HODGES,

Of Counsel.

We hereby certify that we have read the foregoing petition for Certiorari, and that in our opinion it is well founded and presents grounds whereon the prayer ought to be granted; and we further certify that it is not intended for purposes of delay.

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Of Counsel.

IN THE

Supreme Court of The United States

October Term, 1944

THE HOOVER COMPANY,**vs.****CONWAY P. COE, Commissioner of Patents,**

**BRIEF IN SUPPORT OF PETITION FOR WRIT OF
CERTIORARI.**

The Opinion of the Court Below.

The opinion of the Court of Appeals for the District of Columbia is reported at 125 App. D. C., F. (2d), 62 U. S. P. Q. 115, and appears herewith in the record filed herewith (R. 140).

The District Court did not enter an opinion, but its findings of fact and conclusions of law appear in the record (R. 10).

Jurisdiction.

The grounds on which the jurisdiction of this Court is invoked follow:

- (1) The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code, 28 U. S. C. 347, as amended by the Act of February 13, 1925.

(2) The judgment of the United States Court of Appeals for the District of Columbia was entered on July 10, 1944.

(3) The foregoing judgment was entered on appeal from a judgment by the District Court for the District of Columbia in a suit in equity brought under the Revised Statutes, Section 4915, 35 U. S. C. 63, as amended by Act of August 5, 1939, to have remedy from the refusal of the Board of Appeals of the Patent Office to grant a patent to Petitioner as assignee of reissue patent application Serial No. 373,970, filed by Curtis C. Coons.

(4) Some of the previous decisions of this Court which are believed to sustain jurisdiction in this case are:

Butterworth v. Hill, 114 U. S. 128.

Gandy v. Marble, 122 U. S. 432.

Morgan v. Daniels, 153 U. S. 120.

Steinmetz v. Allen, 192 U. S. 543.

American Steel Foundries v. Robertson, 262 U. S. 209.

Statement of the Case.

The facts are set forth in the Petition.

Specification of Errors.

The errors which the petitioner will urge, if the Writ of Certiorari is issued, are that the Court of Appeals for the District of Columbia erred:

1. In affirming the dismissal of Petitioner's Bill of Complaint and upon the grounds that the District Court had no jurisdiction under the provisions of Section 4915, R. S.

2. In holding, contrary to past practice, that Petitioner was not entitled to relief under the provisions of Section

4915, R. S. after having been refused a patent by the Board of Appeals and because he had not established priority of invention over another claiming the same invention, the Patent Office having refused to set up an interference to determine the question of priority after having been requested to do so by Petitioner and in conformance with its long-established practice.

3. In holding, contrary to past practice, that Petitioner is not entitled to relief under Section 4915, R. S. because a third party, who was not an adverse party to Petitioner in the Patent Office, was not made a party defendant to the action in addition to the Commissioner of Patents, there having been a refusal to grant the patent to Petitioner by the Board of Appeals of the Patent Office but no interference or decision by the board of interference examiners.

4. In refusing to decide the case upon its merits and instead dismissing upon the grounds of lack of jurisdiction.

Summary of Argument.

1. Section 4915 R. S. conveys jurisdiction upon the District Court for the District of Columbia of an action begun by bill in equity by an applicant who has been refused a patent by the Board of Appeals and the fact that further prosecution may take place in the Patent Office in "complying with the requirements of law," should the Court hold for the applicant, does not deprive the Court of its jurisdiction.

2. The question of the District Court's jurisdiction depends upon the construction of Section 4915 R. S. and is of great public importance.

3. This Court has not ruled upon the question of the District Court's jurisdiction of an action brought under Section 4915, R. S. in a case in which, following a decision favorable to the complainant, further prosecution might

take place in the Patent Office, and the decision of the Court of Appeals for the District of Columbia has not given proper effect to the applicable decisions of this Court.

4. The judgment and opinion of the Court of Appeals holding that the Court has no jurisdiction of an action brought under Section 4915, R. S. may seriously hinder and confuse the administration of the law in the Patent Office, particularly with respect to Section 4904, R. S. (Appendix, p. 2).

5. The provision in Section 4915 R. S. of a "remedy by bill in equity" . . . "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the Board of interference examiners," provides for remedies under two separate conditions.

6. In an *ex parte* action brought under Section 4915 R. S. by an applicant after refusal of a patent by the Board of Appeals, a third party claiming the same invention is not a necessary party where no interference between applicant and the third party was instituted by the Patent Office.

ARGUMENT.

1. **Section 4915 R. S. (Appendix, p. 3) Conveys Jurisdiction Upon the District Court for the District of Columbia of an Action Begun by Bill in Equity by an Applicant Who Has Been Refused a Patent by the Board of Appeals and the Fact that Further Prosecution May Take Place in the Patent Office in "Complying With the Requirements of Law" Should the Court Hold for the Applicant Does Not Deprive the Court of Its Jurisdiction.**

Section 4915 R. S. has been in existence since 1836. It clearly gives an applicant the right to seek relief from the refusal of a patent by the Patent Office Board of Appeals.

by filing a bill in equity. (*Bakelite Corp. v. Nat'l Aniline & Co.*, 83 F. (2d) 176.)

Petitioner was refused a patent containing Claims 15, 16, 38 and 39 and was entitled to bring an action in the District Court for the District of Columbia against the Commissioner of Patents. The Court of Appeals below was of the opinion that the present case was not covered by the statute even though it fell within the precise wording thereof because of certain facts which appeared in the record of the case but which facts might be true in any case ever brought under the statute. These facts were that the record showed that further prosecution might be necessary in the Patent Office should the Court's decision be in favor of the applicant.

The statute itself provides that after a favorable decision in the action brought under Sec. 4915 R. S. an applicant is only entitled to a patent upon "filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law." The provision "otherwise complying with the requirements of law" clearly envisages the duty residing on the applicant of successfully overcoming any legal barrier raised by the Commissioner to the grant of a patent as "authorized" after the return of the application to the Patent Office; and the Courts have so stated.

In *Gandy v. Marble*, 122 U. S. 432, 1887, this Court said:

"* * * the Commissioner is not authorized to issue the patent unless the applicant otherwise complies with the law."

In *Philadelphia Storage Battery Co. v. Zenith Radio Corp.*, C. C. A. 7th, 117 F. (2d) 642, 645, the Court said:

"We do not understand that Section 4915 of the Revised Statutes contemplates that the Court shall direct the Commissioner to issue a patent. This must

be true because there are other matters which the department must decide favorably to Jacke's assignee before a patent can issue to it. The statute which authorizes the issuance of patents must be complied with in every respect, and we have no power under Section 4915 to restrict those requirements."

It is the usual practice in the Patent Office to consider the "other requirements of the law" when a case is returned to the Patent Office after a favorable decree under Section 4915, R. S. Examples of this practice are: *Gold v. Newton*, 254 F. 824; *Radtke Patents Corp. v. Coc*, 74 App. D. C. 251; 122 F. (2d) 937. *Tully v. Robertson*, 19 F. (2d) 954. Rule 96, Rules of Practice of the Patent Office (Appendix, p. 7), states:

"After judgment of priority the application of any party may be held for revision and restriction, subject to interference with other applications."

The same is true after a case is allowed *ex parte*. The above rule applies whether the judgment is by the examiner or the Court under Section 4915 R. S. Subsequent Patent Office prosecution could comprise a previously anticipated or new discovered interference as provided in Section 4904 R. S. (Appendix, p. 2). That subsequent interferences do occur is evidenced by the facts of many cases, see *Gold v. Newton*, 254 F. 824; *Radtke Patent Corp. v. Coc*, 122 F. (2d) 937. Subsequent Patent Office prosecution might also comprise action for the first time upon the merits of an invention, as in a case in which the Board of Appeals refused a patent upon the sole grounds that the applicant could not claim the invention at all, as in *Frash v. Moore*, 211 U. S. 1, and *Steinmetz v. Allen*, 192 U. S. 543, *Pitman v. Coc*, 68 F. (2d) 412.

If the Patent Office prosecution of an application must be complete in order properly to bring an action under

Section 4915 R. S. then a great number of actions which have been brought under Section 4915 R. S. where the grounds of rejection was one of estoppel, and where further Patent Office prosecution would clearly be necessary, have been heard by the District Courts in error. Examples are: *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, App. D. C. 1936, *De Pont v. Coe*, 89 F. (2d) 679, App. D. C. 1937, *American Cyanamid v. Coe*, 106 F. (2d) 851, App. D. C. 1939, *American Viscose Corp. v. Coe*, 106 F. (2d) 849, App. D. C. 1939, *Power Patents Co. v. Coe*, 110 F. (2d) 550, App. D. C. 1940, *Bendix Aviation Corp. v. Coe*, 61 U. S. P. Q. 78, D. C. D. C. 1943, *Bates et al. v. Coe*, 40 U. S. P. Q. 220, D. C. D. C., *Tinnerman Products v. Coe*, 50 F. S. 337, D. C. D. C., *Gyro Process Co. v. Coe*, 107 F. (2d) 195, 42 U. S. P. Q. 413. It is to be presumed that the Courts in these cases assumed the duty which was theirs of determining their own jurisdiction. *Minnesota v. Hitchcock*, 185 U. S. 373, *Reid v. U. S.*, 211 U. S. 529.

That a decision not going to the merits but instead requiring an applicant to divide his application and claim part of his invention in separate applications is "final and appealable" was determined by this Court in *Steinmetz v. Allen*, 192 U. S. 543. The Court there said:

"True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yields to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. (Sec. 4894 Rev. Stats.) A ruling having such effect must be considered as final and appealable."

In the *Steinmetz* case Steinmetz was seeking a writ of mandamus to compel the Commissioner to forward his appeal from the requirement of division to the Examiners-in-

Chief (now Board of Appeals). This Court's decision was that the Examiner's holding was "final." Clearly an affirmation of the Examiner by the Board of Appeals upon appeal would render the decision no less "final."

Revised Statute 4915 (Appendix, p. 3) provides a remedy by bill in equity when a "patent or application is refused" by the Board of Appeals. No limitation is provided as to the grounds of the Board's refusal. Clearly in the performance of its judicial function (*Butterworth v. Hoe*, 112 U. S. 50, *U. S. ex rel. Bernardin v. Duell*, 172 U. S. 576) the Board can base its decision upon any ground it sees fit, as can a Court in making a decision. The decision is final so far as the applicant is concerned for he is deprived of his patent. It is no less final, from his aspect, merely because subsequent prosecution may be necessary should the decision be reversed. The decision of the lower Court adding limitations as to the grounds upon which the "patent or application is refused" and still bring the refusal within the statute must be considered judicial legislation.

The refusal of a patent upon one ground has the same final effect as the refusal upon another ground and Section 4915 R. S. does not distinguish. Petitioner was refused a patent containing certain claims upon the grounds that they did not read upon his invention (R. 129). Frash, in the case *Frash v. Moore*, 211 U. S. 1, was denied a patent because of his refusal to comply with a requirement of division, there having been no action upon the merits. Frash appealed to the Court of Appeals for the District of Columbia which then had the jurisdiction now residing in the Court of Customs and Patent Appeals under Section 4911 R. S. (U. S. C. Title 35, Sec. 35a) (Appendix, p. 2). The Court in dismissing the appeal and writ of error and in denying *certiorari* said:

“ * * * the decision of that Court (in the action under Section 4911 R. S.) may be challenged generally and a refusal of patent may be reviewed and contested by bill (under Section 4915 R. S.) as provided.” (Parenthetical matter added.)

The remedy available under Section 4915 R. S. (Appendix, p. 3) is co-extensive with the remedy available under Section 4911 R. S. (Appendix, p. 2). That such is the case was clearly stated by the Court below in comparing the relief available under the two sections in *Pitman v. Coe*, 68 F. (2d) 412, 414, and as follows:

“ There is no reason to believe that Congress intended that any remedy which might be obtained by appeal should be more extensive or complete than that allowed by bill in equity.”

The remedies provided by Section 4911 R. S. and Section 4915 R. S. have long been considered as “alternative and mutually exclusive” (*Hemphill Co. v. Coe*, App. D. C. 121 F. (2d) 897 (1941) remedies available to the applicant refused a patent in the Patent Office (*Chase v. Coe*, 122 F. (2d) 198, *Jensen v. Lorenz*, 92 F. (2d) 992, *certiorari* denied, 302 U. S. 751, *Bakelite v. Nat'l. Acilint*, 83 F. (2d) 176). This fact is also clearly evidenced by the wording of Section 4911 R. S. which in part reads as follows:

“ If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under Section 4915 of the Revised Statutes.”

Trade-mark cases brought under Section 4915 R. S. are subject to the “same rules of practice and procedure” (*American Steel Foundries v. Robertson*, 262 U. S. 209, *Atkins v. Moore*, 212 U. S. 285) as in patent cases. The Court of

Appeals for the District of Columbia does not deny its jurisdiction in such cases where upon returning to the Patent Office further prosecution may take place in "complying with the requirements of law," as is evidenced by its decision in the case of *Thorne, Neal and Co. v. Cor*, 143 F. (2d) 155, 62 U. S. P. Q. 22, decided after the present case was argued.

The concept that the District Court has no jurisdiction where further proceedings may take place in the Patent Office upon the return of the application is believed to be obvious error. The statutory duty placed upon the Commissioner by the Revised Statutes, Section 4904 (Appendix, p. 2) and Rules 94 and 95 of the Rules of Practice in the United States Patent Office (Appendix, pp. 6, 7) require the Commissioner to exercise the judicial function of determining the existence or non-existence of an interference with respect to the application. In the case in which the applicant obtained the allowance of the claims for the first time in the 4915 action the Commissioner would not have had the opportunity previously to exercise this function. If the Court of Appeals recognizes the duty resting upon the Commissioner then logically it can never take jurisdiction of an action brought under Section 4915 R. S.

It is submitted that the District Court did have jurisdiction of Petitioner's complaint filed under the provisions of Section 4915 R. S. and that the holding to the contrary is inconsistent with the law as laid down by this and other Courts, and in fact inconsistent with prior and concurrent law as laid down by the same Court.

2. The Question of the District Court's Jurisdiction Depends Upon the Construction of Section 4915 R. S. (U. S. C. Title 35, Sec. 63) and Is of Great Public Importance.

The District Court's jurisdiction is based upon Section 4915 R. S. (Appendix, p. 5). The interpretation placed

upon the statute by the Court of Appeals is believed to be original with it as no similar holding could be found.

The great importance of the decision below is also evidenced by the scope of its application, *Line Materials Company v. Coc*, 125 App. D. C.; 62 U. S. P. Q. 120; *Colgate Palmolive-Peet v. Coc*, 125 App. C. C.; 62 U. S. P. Q. 121. The lower Court's view of the limits of the law of the case is well evidenced by the question propounded and the Court's statement relative thereto in the decision. The question was:

"Has the Court under section 4915, R. S., the power to hand down a decree which does not determine the right of an applicant to receive a patent but which only determines that claims which may subsequently be held to be unpatentable by the Patent Office are supported by the application?" (R. 140.)

The statement in the decision was:

"On its own motion this Court raised the question whether Section 4915 R. S. confers jurisdiction on the District Court to enter a decree which does not determine the right of the applicant to receive a patent but which instead directs the examiner to allow claims for the purpose of provoking subsequent interference proceedings. Both parties submitted memoranda of authority supporting the jurisdiction of the District Court in the above situation" (R. 141).

The decision below, if unreversed, will deny to all applicants the right to bring a bill in equity under Section 4915 R. S. in the following eight specified cases contrary to the clear intent of the law:

a. In a case in which the refusal of the patent is upon the grounds of estoppel for failure to bring a motion as provided by Rule 109 (Appendix, p. 8), Rules of Practice of the Patent Office.

Where the applicant's patent is refused *ex parte* upon the grounds of estoppel and where the award of priority, in an interference is upon the grounds of estoppel, the record in a subsequent action brought under Section 4915 R. S. will show this fact and will also show that a subsequent interference may be necessary upon a favorable decision for the complainant. Under the doctrine of the instant case applicants in such cases would be deprived of their right to file the bill in equity under Section 4915 R. S. The Court refers to two such cases (*International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, *American Cyanamid Co. v. Coe*, 160 F. (2d) 851) in the decision below. Prior to the present decision the Courts have passed upon many such cases under Section 4915 R. S. (see case cited on p. 15).

b. In cases where the claims are copied from the patent and are later rejected.

In the instant case one of the four claims was copied from the Bergholm patent (R. 134) for purposes of interference and, with the other three claims, was refused by the Patent Office. The same situation was present in the concurrently decided case, *Colgate-Palmolive-Pact Co. v. Coe*, 125 App. D. C.; 62 U. S. P. Q. 121, in which the instant case was cited as the law supporting the above proposition "b". As a matter of fact the subsequent interference may never materialize, for the patentee cannot be forced into an interference. He may disclaim, or he may file a reissue application, and omit the copied claim.

c. In any case in which an interference is dissolved upon any grounds.

The doctrine of *Hoover v. Coe* will deny all applicants the right to have the refusal of their patent re-

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viewed by bill in equity under Section 4915 R. S. where the applicant was previously involved in an interference and the interference was dissolved under the governing Patent Office rules upon any grounds whatsoever. The lower Court has so applied the law of *Hoover v. Coe in Line Material et.al. v. Coe*, 125 App. D. C.; 62 U. S. P. Q. 120.

d. In any case in which a party is eliminated from a multi-party interference upon the ground that he is not entitled to make the claim.

In such a case the interference would continue to an award of priority with the eliminated party prosecuting his application *ex parte*. *Gyro Process Co. v. Coe*, 70 App. D. C. 390, 107 F. (2d) 195. Under the doctrine of *Hoover v. Coe* the parties to the interference and the *ex parte* applicant would have no right to a bill in equity under Section 4915 R. S. for, should the eliminated applicant subsequently prove his right to make the interference counts, a second interference would have to be instituted.

e. In the case in which some of an applicant's claims have been allowed.

The Court below, in holding that applicant had no right to a bill in equity under Section 4915 R. S. when only certain of his claims had been refused, in effect held that unless all of the claims were refused there had been "no refusal of a patent" as provided in Section 4915 R. S. This is contrary to a long established practice, *Gyro Process Co. v. Coe*, 107 F. (2d) 195, *Tully v. Robertson*, 19 F. (2d) 954, *Steinmetz v. Allen*, 192 U. S. 543, *Frasch v. Moore*, 211 U. S. 1. Under the doctrine of this case an applicant who has, for example, one narrow claim allowed would be denied the right to file his bill in equity.

f. In a case in which the Board of Interference Examiners made a ruling under Rule 126 (Appendix, p. 11) of the Rules of Practice in the United States Patent Office.

The Board of Interference Examiners may make a recommendation under Rule 126 (Appendix, p. 11) of the Rules of Practice in the Patent Office to the effect that after a judgment of priority consideration should be given to any matter affecting the right of any party to a patent. Application of this recommendation obviously would require further proceedings in the Patent Office after the determination of the issue of priority in an *inter partes* 4915 action.

g. In a case in which the refusal of a patent is upon the grounds that the applicant had previously elected a different invention, or where the patent is refused upon the failure of the applicant to comply with a requirement for division.

In this case the patent would be refused upon the technical grounds and action upon the merits would necessarily follow a reversal of the Patent Office in an action brought under Section 4915 R. S. This holding, if unreversed, would comprise a complete bar to applicant's right to a patent yet under the decision in the instant case the applicant would be given no right to contest the matter under Section 4915 R. S. The lower Court's decision on this point is inconsistent with the decisions of this Court in *Steinmetz v. Allen*, 192 U. S. 543, *Ex parte Frasch*, 192 U. S. 566, *Frasch v. Moore*, 211 U. S. 1.

h. In any case in which an application has been involved in an interference in the Patent Office.

If jurisdiction does not reside with the District Court when further Patent Office prosecution may be necessary then the Courts will never have jurisdic-

tion in a case involving an application which has been involved in an interference in the Patent Office. In such cases Rule 96 (Appendix, p. 7) specifically provides for further proceedings in the Patent Office including the possibility of a further interference.

The decision below can result in the decisions of the Patent Office becoming final and adverse to the applicant in all cases where a bill under Section 4915 R. S. is filed. The Commissioner need only state in his answer that, should the decree be favorable to the applicant, further proceedings in the Patent Office will be necessary. The District Courts would then, under the law of this case, lack jurisdiction under Section 4915 R. S. The 40-day period for appeal under Section 4911 R. S. to the Court of Customs and Patent Appeals would have long since passed. See Rule 149 (Appendix, p. 13) Rules of Practice of the Patent Office and Rule XXV of the Court of Customs and Patent Appeals (Appendix, p. 14). The applicant (as has complainant in this case) would then be deprived of his right to review under Section 4911 R. S. and Section 4915 R. S. and the decision of the Patent Office would be final insofar as applicant was concerned.

The decision of the Court below, as applied in subsequent decisions of that Court, bases jurisdiction of the District Court in a 4915 action upon an indeterminant factor comprising the degree of likelihood of further proceedings in the Patent Office.

In *Colgate-Palmolive-Peet Company v. Coc*, 125 App. D. C., 62 U. S. P. Q. 121, the doctrine of the present case was applied, while in *Minnesota Mining Company v. Coc*, 125 App. D. C., 62 U. S. P. Q. 119, the doctrine was not applied. These cases were decided on the same day. The facts were substantially the same. In each case the record disclosed that a subsequent interference might take place if the decree was in favor of the complainant, and

that the complainant would be the senior party in such interference.

In this case and in the *Colgate* case the doctrine was applied and jurisdiction denied, the Court in effect holding that the possibility of future proceedings was too proximate. In the *Minnesota Mining* case the doctrine was considered and not applied, the Court below holding in effect that the possibility of future proceedings was too remote.

If the decision below is not reversed, the District Courts will have difficulty in deciding when they do and when they do not have jurisdiction. By the same token applicants will never know whether or not to file a bill under Section 4915 R. S. and take the chance of losing the right of review both under Section 4911 R. S. and Section 4915 R. S.

It is submitted that the lower Court's decision is of great importance and raises questions which should be decided by this Court.

3. This Court Has Not Ruled Upon the Question of the District Court's Jurisdiction of an Action Brought Under Section 4915 R. S. in a Case in Which, Following a Decision Favorable to the Complainant, Further Prosecution Might Take Place in the Patent Office, and the Decision of the Court of Appeals for the District of Columbia Has Not Given Proper Effect to the Applicable Decisions of this Court.

No decision by this Court directly deciding the issues raised below could be found. Decisions by this Court which are applicable and with which the decision below is believed to be inconsistent are *Gandy v. Marble*, 122 U. S. 432, referred to on p. 13; *Steinmetz v. Allen*, 192 U. S. 543, referred to on p. 15; *Frash v. Moore*, 211 U. S. 1, referred to on p. 16.

Under the present practice the Commissioner cannot be sued outside the District of Columbia without his consent.

Butterworth v. Hill, 114 U. S. 128; 5 S. Ct. 796; *Hammar v. Robertson*, 6 F. (2d) 460; *Prentiss v. Ellsworth*, Fed. Case 11386, Whart. Dig. 365, *Vermont Farm Mach. Co. v. Marble*, 20 F. 117. Therefore, it is unlikely that the precise question ruled upon by the Court below will be passed upon in a jurisdiction other than the District of Columbia; wherefore this Court should take the case under consideration by the issuance of a writ of *certiorari* to the Court of Appeals for the District of Columbia.

The need for a ruling by this Court upon the questions presented is made more apparent by the confusion which has resulted from the substantially simultaneous decisions of the Court below. In *Thorne, Neale and Co. v. Coe*, 142 F. (2d) 155; 62 U. S. P. Q. 22; decided after the present case was argued and twenty-eight days prior to the decision therein, the Court below failed to apply the law of this case in a trade-mark case. In *Minnesota Mining and Mfg. Co. v. Coe*, F. (2d), 62 U. S. P. Q. 119; decided the same day as the instant case, the Court below in a footnote

(Footnote: "A few of the claims are copied from other applications which were filed later than the original application in this case. It is not clear that the doctrine of *Hoover v. Coe*, (No. 8602, decided this day (62 U. S. P. Q. 115)), applies to these claims because it may be that if they were held to be patentable the record contains enough evidence to show that the plaintiff was prior in time without the necessity of further interference proceedings. It is unnecessary to decide this question because the appeal involves a number of similar claims which were not copied.")

stated that the doctrine of *Hoover v. Coe* was not applicable because of the facts in the *Minnesota Mining Co.* case which it specified and which are on all fours with the facts in the instant case. In the instant case, as in the *Min-*

nesota Mining Co. case, "a few" (one) of the claims were copied from an application (the Bergholm patent) (R. 134), which was filed (R. 137) later than the original Hoover application (R. 112a). In the Hoover case, as in the Minnesota case, "it may be" that "the record contains enough evidence to show that the plaintiff (Hoover) was prior in time without the necessity of further interference proceedings." In the Hoover case as in the Minnesota case "the appeal (a 4915 action in each case) involves a number of similar claims which were not copied."

It is submitted that with this conflict and confusion in the law in the one Court having jurisdiction of *ex parte* 4915 actions the need for clarification is obvious.

4. The Judgment and Opinion of the Court of Appeals Holding the Court Has No Jurisdiction of an Action Brought Under Section 4915 R. S. May Seriously Hinder and Confuse the Administration of the Law, in the Patent Office, Particularly With Respect to Section 4904 R. S.

The administration of the patent law in the Patent Office will be seriously confused and hindered by virtue of the many rules of practice which are inconsistent with the decision of the Court of Appeals, as discussed below.

The Patent Office is the administrative body specifically designated by Congress to administer the Patent Laws insofar as the issuance of patents are concerned, Section 481 R. S. (U. S. C., Title 35, Section 6) (Appendix, p. 1).

There can be no doubt that the administrative rules set up by the administrative body having jurisdiction of the administration of an act of Congress over a long period of time, during which the act was frequently amended with such rules in view, should be virtually conclusive as to the interpretation of the statutes in question. *Dismuke v. U. S.* 297 U. S. 167; *Scott Logan v. Davis*, 233 U. S. 613; *Kern*

River Co. v. U. S., 257 U. S. 147; *U. S. v. State of Minnesota*, 270 U. S. 181; *U. S. v. Jackson et al.*, 280 U. S. 183.

Under the decision below practically all of the rules of the Patent Office relating to the administration of R. S. Sec. 4904 (Appendix, p. 2) will have to be changed if an applicant's rights provided by statute are to be preserved. These rules "have the force and effect of law" (*Ewing v. United States, ex rel. Fowler Car Co.*, 244 U. S. 1), and comprise an authority "under the United States" (*Steinmetz v. Allen*, 192 U. S. 543, 556).

This Court has held that the mere allegation in a petition for writ of certiorari "that the judgment and opinion below might seriously hinder future administration of the law was grave and sufficiently probable to justify issuance of the writ." (*Fed. Trade Comm. v. Amer. Tobacco Co.*, 274 U. S. 543.)

Rules 93, 94, 95 and 96 (Appendix, pp. 5, 6, 7) of the Patent Office require that the counts or claims be patentable to all parties before an interference is instituted. Furthermore Rule 96 provides for the setting up of other interferences after a judgment of priority in a first interference. Rule 63d (Appendix, p. 5) makes provision for rejecting claims copied from a patent in certain cases. Rules 111, 116, 122, 123 and 124 (Appendix, pp. 9, 10, 11) of the Patent Office have to do with motions to dissolve and with the dissolution of interferences. Rule 126 (Appendix, p. 11) has to do with calling the Commissioner's attention to facts, which came to the notice of the board of interference examiners and which would indicate that the claims are unpatentable to either party and provides for further proceedings in the Patent Office in such a case. Rule 130 (Appendix, p. 11) of the Patent Office has to do with the question of raising patentability of the issue to an opponent as a basis for a priority decision only when a motion

had been duly brought. Rule 133 (Appendix, p. 12) provides for appeals to the Board of Appeals and includes the question of division or previous election which do not go to the merits in the sense of novelty, patentability, etc., and the decision of which would not end the prosecution of the case before the Patent Office. Rule 141 (Appendix, p. 12) specifically provides for further proceedings in the Patent Office after a decision by an appellate tribunal.

All of the foregoing rules provide for further proceedings in the Patent Office after the refusal of a patent. Under the decision below, if the District Court is to have jurisdiction further proceedings must not take place in the Patent Office. If an applicant's rights under Sec. 4945 R. S. are to be preserved, under the decision below, those rules must be changed:

It is submitted that the probability of confusion in the administration of the statutes in the Patent Office which will be caused by the decision below is sufficient reason for the Supreme Court to take jurisdiction and to review the decision.

5. The Provision in Section 4915 R. S. of a "Remedy by Bill in Equity" * * * "Whenever a Patent on Application Is Refused by the Board of Appeals or Whenever Any Applicant Is Dissatisfied With the Decision of the Board of Interference Examiners," Provides for Remedies Under Two Separate Conditions.

Section 4915 R. S. (Appendix, p. 3) clearly provides a patent applicant in the United States Patent Office with remedies in two distinct cases: He may file a bill in equity when:

- (1) "a patent on application is refused by the Board of Appeals"
- "or whenever"
- (2) "dissatisfied with the decision of the board of interference examiners."

The decision of the Court below refuses to grant an applicant the remedy of (1) unless (2) is also present in any case where an interference might be set up at a later date. The word "or" is interpreted to mean "and."

The decision below requires that the interference be set up even though the Commissioner is of the opinion that none should exist. Such a holding is clearly inconsistent with the holding of this Court in *Ewing v. Fowler Car Co.* (244 U. S. 1). The Court there said:

"If it could be conceded that there is antagonism between Sec. 4904, and the rules, the former must prevail. *Steinmetz v. Allen*, 192 U. S. 543, 565. But there is no antagonism. The former provides that 'when-ever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application . . . he shall direct the primary examiner to proceed to determine the question of priority of invention.' The section, therefore, commits to the opinion (judgment) of the Commissioner the effect of an application upon a pending one—whether it will interfere with a pending one; something more, therefore, than the fact of two applications, something more than the mere assertion of a claim. The assertion must be, in the opinion of the Commissioner, an interference with another. And it is this other that is first in regard, not to be questioned except at the instance of the Commissioner by an exercise of judgment upon the circumstances. And there is no defeat of ultimate rights; there may be postponement of their assertion remitted to a suit in equity under Sec. 4918."

The same case is authority for the statement that in the present case the applicant could not mandamus the Commissioner to institute the interference which the lower Court contends must exist if it is to have jurisdiction.

Such holding clearly ignores the express provisions of Section 4904 R. S. (Appendix, p. 2), which reads in part as follows:

"Whenever an application is made for a patent which, *in the opinion of the Commissioner*, would interfere with any pending application, or with an unexpired patent, he * * * shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention." (Italics added.)

It also ignores Rule 94 (Appendix, p. 6) of the Rules of Practice in the United States Patent Office which rules comprise an authority "under the United States" (*Steinmetz v. Allen*, 192 U. S. 543, 556). Rule 94 provides:

"Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention *which are allowable in the application of each party*, and * * * between applications for patent, or for reissue, and unexpired original or re-issued patents, of different parties, when such applications and patents contain claims for substantially the same invention *which are allowable in all of the applications involved*." * * * (Italics added.)

To arrive at its holding the Court of Appeals must interpret "or" to be "and" and in doing so violates established principles of statutory interpretation.

The Rules of Practice in the United States Patent Office represent the Commissioner's interpretation of the statutes and, he being an administrative officer charged with the duty of administering the law, the interpretations are entitled to great weight and being of long standing, are not lightly to be overturned. *Dismuke v. United States*, 297 U. S. 167; *U. S. v. State of Minn.*, 270 U. S. 181; *U. S. v. Jackson*, 280 U. S. 183; *Kern River v. U. S.*, 257 U. S. 147; *Scott Logan v. W. R. Davis*, 233 U. S. 613; *United States v. Moore*, 95 U. S. 760; *Hastings et al. v. Whitney*,

132 U. S. 357; *United States v. Alabama G. S. R. Co.*, 142 U. S. 615; *Kindred v. Union P. R. Co.*, 225 U. S. 582.

In interpreting any statute in the absence of ambiguity, the ordinary meaning of its words and language control *Maillatd v. Lawrence*, 16 How. 251; *United States v. Willberger*, 5 Wheat. 76; *Ruggles v. Illinois*, 108 U. S. 526; *Putnam v. Longley*, 28 Mass. 487.

It is well settled that conjunctive words are to be construed as disjunctive, and vice versa, when and only when it is necessary to effectuate the obvious intention of the legislature. *Beasley v. Parnell*, 177 Ark. 912, 9 S. W. (2d) 10; *In re Steineruck's Insolvency*, 74 A. 360, 225 Pa. 461; *Weir v. Bauer*, 286 Pa. 936; *State v. Tiffany*, 44 Wash. 602, 87 P. 932; 59 C. J. 986, Sec. 584; *Gar Creek Drainage Dist. v. Wagner*, 256 Ill. 338, 100 N. E. 190, 193; *Aurora Brewing Co. v. Ind. Bd. of Ill.*, 277 Ill. 142, 115 N. E. 207; *Foight v. Indus. Comm.*, 297 Ill. 109, 130 N. E. 470; *State ex rel. Normile v. Cooney*, 100 Mont. 391, 47 P. (2d) 637.

It clearly cannot be contended logically that the word "or" of Section 4915 R. S. must be interpreted as "and" in view of the express provisions of related statutes which are inconsistent with such a view.

Section 4911 R. S. (Appendix, p. 2) provides for appeals to the United States Court of Customs and Patent Appeals in *ex parte* and *inter partes* cases. Parallel to Section 4915 R. S. it provides for relief from decisions of the Board of Appeals and from the board of interference examiners.

As to appeals from the Board of Appeals Section 4911 R. S. states that if an applicant takes such appeal "he waives his rights to proceed under section 4915 of the Revised Statutes." The disjunctive "or" is not used in Section 4911 R. S. The wording of the statute quoted in-

dicates the legislative opinion that the right to proceed under either statute resides in the applicant.

As to appeals from the board of interference examiners to the United States Court of Customs and Patent Appeals, this right is given in a separate sentence and here the opposing adverse party may elect "to have all further proceedings conducted as provided in section 4915 of the Revised Statutes."

It appears, therefore, from the wording of Section 4911 R. S. that appeals to the Court of Customs and Patent Appeals from either the Board of Appeals or from the board of interference examiners might have been made the subject matter of a 4915 action.

The view is further supported when it is recalled that to insist that "or" means "and" in Section 4915 R. S. is to make an applicant's right to a clearly given remedy from an adverse decision of the Board of Appeals dependent entirely upon the "opinion" of the Commissioner as to whether an interference should be declared.

The holding below that the Court cannot give judgment authorizing the Commissioner to issue a patent to applicant containing the claims in issue in the absence of other parties claiming the same invention is inconsistent with Section 4918 R. S. (Appendix, p. 4). That statute clearly provides for the determination of the adverse interests of interfering patents.

It is submitted that the word "or" in Section 4915 R. S. is to be given its usual meaning as a disjunctive in the absence of indication of legislative intent to the contrary and particularly in the presence of legislative intent to that effect.

6. In an Ex Parte Action Brought Under Section 4915 R. S. by an Applicant After Refusal of a Patent by the Board of Appeals, a Third Party Claiming the Same Invention Is Not a Necessary Party Where No Interference Between Applicant and the Third Party Was Instituted by the Patent Office.

The Court below held it "had no jurisdiction over this suit" and gave as a reason that "The party against whom the plaintiff claims priority is not before the court" (R. 142).

The bill of complaint in the District Court (R. 3) did not name any other party defendant than the Commissioner of Patents, nor did it claim priority with respect to any other party save to allege (R. 6, paragraph 15) that the claimed invention of complainant's application was "new and useful and was not known or used by others in this country before Coons' invention thereof," as is required to entitle an applicant to a patent under Section 4886 R. S. (Appendix, p. 1). The Commissioner of Patents' answer (R. 8) did not deny the allegation of the complaint which, under F. R. C. P. 8(d) (Appendix, p. 14), is to be taken as admitted. As the Commissioner is the officer charged by law with the duty (Section 481 R. S.) (Appendix, p. 1) of issuing patents, this admission on the face of the pleadings is entitled to full acceptance.

There had been no interference in the Patent Office and there were no other adverse parties which could properly have been named parties defendant. *Dracket Co. v. Chamberlain Co.*, 10 F. S. 851, affirmed 81 F. (2d) 866; *Coe v. Hobart*, 102 F. (2d) 270; *Fessenden v. G. E.*, 10 F. S. 846. In the latter case the Court said:

"Plaintiff can bring no suit against the defendant in this or any other court because of an attempt to have an interference proceeding followed by the dis-

solution thereof. His only cause of action is against the Commissioner of Patents on the assumption that the dissolution of the interference proceedings, because of assumed lack of disclosure of the invention claimed, is equivalent to a denial of the patent. * * *

The District Court's jurisdiction as to such parties would be under the provisions of the second paragraph of Section 4915 R. S. (Appendix, p. 3) and the decisions deny such jurisdiction of another applicant or patentee in a 4915 action where no interference had been instituted in the Patent Office.

The decision below upon this point is directly contrary to the same Court's decision in the trade-mark case decided after the instant case was argued. *Thorne, Neale and Co. v. Coe*, 143 F. (2d) 155, 62 U. S. P. Q. 22. That trade-mark cases are parallel to patent cases has been mentioned before and has been definitely established. *Atkins v. Moore*, 212 U. S. 285; *American Steel Foundries v. Robertson*, 262 U. S. 209; *Baldwin v. Howard*, 256 U. S. 35.

The requirement that a potential future adverse party be made a party defendant in an *ex parte* 4915 suit, represents a departure from the practice followed in a long line of cases.

In all cases in which the applicant is denied a patent upon the grounds of estoppel to make claims and where a subsequent interference would result should he succeed in a 4915 action the present holding in the lower Court requiring the naming of the potential interferant as a defendant is applicable. Cases evidencing that over a period of many years the Court below has not required the presence of the potential future interferant in such cases are here listed; *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, App. D. C. 1936; *Du Pont v. Coe*, 89 F. (2d) 679, App. D. C. 1937; *American Cyanamid v. Coe*,

106 F. (2d) 831, App. D. C. 1939; *American Viscose Corp. v. Coe*, 106 F. (2d) 849, App. D. C. 1939; *Power Patents Co. v. Coe*, 110 F. (2d) 550, App. D. C. 1940; *Bendix Aviation Corp. v. Coe*, 61 U. S. P. Q. 78, D. C. D. C. 1943; *Bates et al. v. Coe*, 40 U. S. P. Q. 220, D. C. D. C.; *Tinnerman Products v. Coe*, 50 F. S. 337, D. C. D. C.; *Gyro Process Co. v. Coe*, 107 F. (2d) 195, 42 U. S. P. Q. 413. The Court of Appeals in the Second Circuit also has taken jurisdiction of such cases. *Gold v. Newton*, 254 F. 824; *Barrett v. Ewing*, 242 F. 506. It is to be presumed that the Court in all of these cases assumed its duty of determining its jurisdiction. *Minnesota v. Hitchcock*, 185 U. S. 373; *Reid v. U. S.*, 241 U. S. 529.

It is submitted that the requirement by the lower Court that a potential future interferant be named as a party defendant in an *ex parte* 4915 action is clear error. Such party is not a necessary party under the decisions and the governing statute.

CONCLUSION.

For the foregoing reasons it is believed that this Court should be moved to grant the writ of certiorari to the end the fundamental questions of patent law here involved may be settled by this Court and the judgment of the Court below reversed.

Respectfully submitted,

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APPENDIX.

Statutes:

SEC. 481. R. S. (U. S. C., title 35, sec. 6.) The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

SEC. 4886. R. S. (U. S. C., title 35, sec. 31.) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon proceeding had, obtain a patent therefor. [The period is *two years* instead of "one year" where the application was filed prior to Aug. 5, 1940. See Sec. 2 of Act of Aug. 5, 1939, *infra*.]

Act of Aug. 5, 1939, 53 Stat. 1212:

SEC. 2. This Act [amending sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 62, 69, and 73) by changing "two years" to *one year*] shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications: *Provided, however,* That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

SEC. 4904. R. S. (U. S. C., title 35; sec. 52.) Whenever an application is made for a patent which, in the opinion of the Commission, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commission may issue a patent to the party who is adjudged the prior inventor. [As to interferences declared prior to Oct. 5, 1939, see Sec. 5 of Act of Aug. 5, 1939, *infra*.]

Act of Aug. 5, 1939, 53 Stat. 1212:

SEC. 5. This Act [amending sections 4904, 4909, 4911, and 4915 of the Revised Statutes (U. S. C., title 35, secs. 52, 57, 59a, and 63)] shall take effect two months after its approval; but it shall not affect interferences then pending, which may be heard and decided and appeals and other proceedings taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended.

SEC. 4911. R. S. (U. S. C., title 35, sec. 59a.) If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. (U. S. C., title 35, sec. 63.) If any party to an interference is dissatisfied with the decision of the board of interference examiners he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes. (U. S. C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions ap-

pealed from shall govern the further proceedings in the case [As to interferences declared prior to Oct. 5, 1939, see sec. 5 of Act of Aug. 5, 1939, printed after R. S. sec. 4904, *ante*.]

SEC. 4915. R. S. (U. S. C., title 35, sec. 63.) Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. [As to interferences declared prior to Oct. 5, 1939 see Sec. 5 of Act of

Aug. 5, 1939, printed after R. S. Sec. 4904, *ante.*]

Act of Mar. 3, 1927, 44 Stat. 1394 (U. S. C., title 35, sec. 72a):

And upon the filing of a bill in the District Court of the United States for the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes (U. S. C., title 35, sec. 63 or sec. 66), without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section (sec. 113 of title 28 U. S. C.): *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

SEC. 4918. R. S. (U. S. C., title 35, sec. 66.) Whenever there are interfering patents, any person interested in any of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both the patents void in whole or in part upon any ground, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

Rules of Practice in the United States Patent Office:

63. (d) Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents.

Where an applicant copies claims from a patent and the examiner is of the opinion that he can make none of these claims, he should state in his action why he can not make the claims and set a time limit, not less than twenty days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit should be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed, will in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed. (See rule 94.)

93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent. In order to ascertain whether any question of priority arises the Commissioner may call upon any junior applicant to state in writing under oath the date and the character of the earliest fact or act, susceptible of proof, which will be relied upon to establish conception of the invention under consideration. The sworn statement filed in compliance with this rule will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than twenty days, the Commissioner will proceed upon the assumption that the said date is the date of the oath attached to the application. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the

Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

94. Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention in controversy in this country before the filing date of the patentee; and when required the applicant shall file an affidavit setting forth facts showing that he completed the invention in controversy, in this country, before the filing date of the patentee.

Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion he cannot make the other claims and state further that the interference will be promptly declared and that the applicant may proceed under rule 109, if he further desires to contest his right to make the claims not included in the declaration of the interference.

Where an applicant presents a claim copied or substantially copied from a patent, he must at the time he presents the claim identify the patent, give the number of the patented claim, and specifically apply the terms of the co. claim to his own disclosure.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted.

Parties owning applications or patents which contain conflicting claims will be required to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership.

95. Before the declaration of interference it must be determined that there is common patentable subject matter in the cases of the respective parties. The issue must be clearly defined and be patentable to the respective parties, subject to the determination of the question of priority.

In case the subject matter in controversy has been patented to one of the parties but is deemed by the examiner not to be patentable to an applicant, he shall call the case to the attention of the Commissioner.

96. Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignee, as well as to the attorney or agent of record in each case. The parties to whom the claims are suggested will be required to make those claims within a specified time in order that an interference may be declared. Upon the failure of any applicant to make any claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by that claim unless the time be extended upon a proper showing. After judgment of priority the application of any party may be

viii.

held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney or agent, the examiner shall notify each of said principal parties and also the attorney or agent of this fact.

109. An applicant involved in an interference may, within a time fixed by the examiner of interferences not less than thirty days after the preliminary statements (referred to in rule 110) of the parties have been received and approved, or if a motion to dissolve the interference has been brought by another party, within thirty days from the filing thereof, on motion duly made as provided by rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties.

Such motion must be accompanied by the proposed amendment, and when in proper form will be set by the examiner of interferences for hearing before the primary examiner. Where a party opposes the admission of such an amendment in view of prior patents or publications, full notice of such patents or publications, applying them to the proposed counts, must be given to all parties at least twenty days prior to the date of hearing. On the admission of such amendment and the adoption of the claims by the other parties within a time specified the primary examiner shall redeclare the interference or shall declare such other interferences as may be necessary to include the said claims. New preliminary statements will be received as to the added claims, but motions for dissolution with regard thereto will not be considered where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of

the interference without the consent of the Commissioner, except as provided herein and in rule 106.

Any party to an interference may bring a motion to put in interference any claims already in his application or patent which should be made the basis of interference between himself and any of the other parties. Any party to an interference may bring a motion to add or substitute any other application owned by him, as to the existing issue, or to include an application or a patent owned by him, as to claims which should be made the basis of interference between himself and any of the other parties. Such motions are subject to the same conditions and the procedure in connection therewith is the same, so far as applicable, as hereinabove set forth for motions to amend.

111. The preliminary statements shall not be opened to the inspection of the opposing parties until all motions to dissolve under rule 122 and all motions to amend under rule 109 and interlocutory appeals respecting the same have been fully disposed of or the time for filing such motions has expired without such a motion having been filed, and the case is in condition for taking of testimony.

A junior party who fails to file a preliminary statement or a party who alleges no date in his preliminary statement earlier than the filing date of the application or applications of another party shall not have access to the preliminary statement of said party.

If the interference be terminated by dissolution, the preliminary statements will remain sealed.

116. The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

The termination of the interference by dissolution under rule 122 without an award of priority shall not disturb this presumption, and a party enjoying the status of a senior party with respect to any subject-matter of his application shall not be deprived of any claim to such subject-matter solely on the ground that such claim was not added to the interference by amendment under rule 109.

122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, or (4) if the interference involves a design patent or an application, alleging that there is no interference in fact and also motions to shift the burden of proof, should contain a full statement of the ground relied upon and should, if possible, be made within the time fixed by the examiner of interferences, not less than thirty days, after the statements of the parties have been received and approved. Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner, due notice of the day of hearing being given by the office to all parties. If in the opinion of the examiner of interferences the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.

At a hearing on a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file shall be referred to for the purpose of construing the issue. The matter raised on a motion to shift the burden of proof may be reviewed at final hearing.

123. Setting a motion brought under the provisions of rule 109 or of rule 122 for hearing will act as a stay of pro-

ceedings pending the determination of the motion. To effect a stay of proceedings in other cases, motion should be made before the tribunal having jurisdiction of the interference, who will, sufficient ground appearing therefor, order a suspension of the interference pending the determination of such motion.

124. No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.

Appeals may be taken directly to the Commissioner from decisions on such other motions as, in his judgment, should be appealable.

126. The board of interference examiners may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

130. Where the patentability of a claim to an opponent is material to the right of a party to a patent, said party may urge the nonpatentability of the claim to his opponent as a basis for the decision upon priority of invention. A

party shall not be entitled to raise this question, however, unless he has duly presented and prosecuted a motion under rule 122 for dissolution upon this ground or shows good reason why such a motion was not presented and prosecuted.

At final hearing between an applicant and a patent the prior art of record in the patent file shall be referred to for the purpose of construing the issue.

133. Every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty, or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed, or because the amendment involves a departure from the invention originally presented; and every applicant who has been twice required to divide his application, and every applicant for the reissue of a patent whose claims have been twice rejected for any of the reasons above enumerated, or on the ground that the original patent is not operative or invalid, or if so inoperative or invalid that the errors which rendered it so did not rise from inadvertence, accident, or mistake, may, upon payment of a fee of \$15, appeal from the decision of the primary examiner to the board of appeals. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent.

141. After decision by an appellate tribunal the case shall be remanded at once to the primary examiner, subject to the applicant's right of appeal, for such action as will carry into effect the decision, or for such further action as the applicant is entitled to demand.

149. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within forty days, exclusive of Sundays and legal holidays in the District of Columbia but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing: *Provided*, however, that if a petition for rehearing or reconsideration is filed within 20 calendar days after said decision, the notice of appeal may be given and the reasons of appeal filed within 15 calendar days after action on the petition. No petition for rehearing or reconsideration filed more than 20 calendar days after such decision, nor any proceedings on such petition, shall operate to extend the period of 40 days hereinabove provided for appeal.

If an applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under section 4915 R. S. (U. S. C., title 35, sec. 63).

If a defeated party to an interference proceeding appeals to the U. S. Court of Customs and Patent Appeals, and any adverse party to the interference shall, within twenty days after the appellant shall have filed notice of the appeal to the court, file notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 4915 R. S., certified copies of the foregoing papers will be transmitted to the U. S. Court of Customs and Patent Appeals for such action as may be necessary. The notice of election must be served as provided in rule 154 (b). [See rule 153 (a).]

From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option

of proceeding under section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals.

Rules of Civil Procedure:

8(d) EFFECT OF FAILURE TO DENY. Averments in a pleading to which a responsive pleading is required, other than those as to the amount of damage, are admitted when not denied in the responsive pleading. Averments in a pleading to which no responsive pleading is required or permitted shall be taken as denied or avoided.

Rules of U. S. Court of Customs and Patent Appeal:

Rule XXV.

1. Any party desiring to appeal to this court from a decision of the Board of Appeals, Board of Interference Examiners or the Commissioner of Patents shall file in the clerk's office a petition, addressed to the court, in which he shall briefly set forth and show that he has complied with the requirements of section 4912 and 4913 of the Revised Statutes of the United States to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the commissioner. Said reasons for appeal, having been filed with the Commissioner of Patents and made a part of the record, shall not be repeated in the petition of appeal. Said petition of appeal and a certified copy of the record in the proceeding shall be filed in this court and the case duly docketed within 40 days (exclusive of Sundays and legal holidays) from the date upon which said reasons for appeal were filed with the Commissioner of Patents: Provided, That the commissioner may for special and sufficient cause extend such time to some definite and fixed date: Provided farther, That in inter partes cases appellant shall, at the time of filing said petition of appeal in this court, or within 10 days

thereafter, serve a copy within 10 days thereafter, serve a copy thereof upon appellee or his counsel.

If said petition of appeal and copy of said record shall not be filed within said period of 40 days, unless such time be extended by the commissioner as heretofore provided, the commissioner, upon such facts being brought to his attention by motion of the appellee in inter partes cases, duly served upon the appellant or his attorney, and upon his own motion in ex parte appeals, may take such further proceedings in the case as may be necessary to dispose of the same as though no notice of appeal had ever been given. Provided, however, That if any adverse party in an interference case shall, within twenty days after appellant shall have filed notice of appeal to this court, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes, certified copies of the notice of appeal and the notice of election shall be transmitted to this court by the Commissioner of Patents for appropriate action according to law.

2. All certified copies of papers and evidence on appeal from the decision of the final appellate tribunal of the Patent Office shall be received by the clerk of this court, and the cases, by titling and number, shall be placed on a separate docket to be designated as the "Patent appeal docket." The clerk shall, under this titling of the case on the docket, make brief entries of all papers filed and of all proceedings had in the case.

3. In making up the transcript of record on appeal it shall be the duty of the Commissioner of Patents to omit the following:

(a) Face and back of file wrappers; formal indorsements on backs of papers.

(b) Printed letterheadings and the like. (Examiners letters and other office letters need show only the date, address, short title, and number of case, body of letter, and signature.)

(c) Notices of publication, of hearings, of decisions, of allowance, of receipt of fees, reference slips, interference cards, and the like (except when material to some question raised on the appeal, and then merely a memorandum need be made—e.g., "Memorandum: Notice of allowance mailed to, address, date").

(d) A patent or other instrument once inserted shall not be inserted a second time, but reference made thereto by memorandum if necessary.

(e) Further to reduce the costs of appeals, it shall be permissible for counsel for the respective parties, subject to the approval of the Commissioner of Patents, to agree upon a statement of the facts of the case, setting forth the questions raised on appeal and so much only of the evidence as may be necessary to a decision of such question. Such statement shall be in duplicate signed by counsel for the parties and filed with the Commissioner of Patents. When so filed, one of the duplicates, together with the decisions of the office, shall constitute the record on appeal and shall be certified accordingly.

4. Appeals from decisions of the Board of Appeals, Board of Interference Examiners and the Commissioner of Patents shall be subject to all the rules of this court provided for other cases therein, except where such rules, from the nature of the case, or by reason of special provisions inconsistent therewith, are not applicable.

